

REMARKS

The Official Action dated January 13, 2006 marked both box 2a indicating that the action is Final and box 2b indicating that the action is Non-Final. Accordingly, Applicants are unclear as to whether the rejection is a Final Rejection or no. In the event that the January 13, 2006 Office Action is considered to be a Final Rejection, Applicants hereby request that this Response also be considered a Request for Continuing Examination. The Commissioner is authorized to charge the fee for a Request for Continuing Examination to deposit account 04-1406 of Applicants' undersigned attorney in the event such a request is necessary.

In the Official Action, the Examiner rejected pending claims 1,3,4,5,8-13 and 17-49 as obvious in light of a combination of numerous prior art patents. However, the prior art cited by the Examiner is directed to systems that are designed for tasks that are different from Applicants' system. Further, the prior art cited by the Examiner does not teach or suggest all of the features of the pending claims. Accordingly, Applicants request that the Examiner reconsider the rejection of the claims.

The primary reference cited by the Examiner is Sansone et al 5,008,287. To understand the differences between Applicants system and Sansone '287 it is helpful to understand the problems that Applicants' system Sansone are directed to and how the systems operate.

Applicants' system is directed to efficiently preparing mixed mail for transport. A stack of mail is input into a feeder that serially feeds the mail onto a transport. The mail pieces are then conveyed to a scanner that scans the pieces to determine the address of the recipient. From the scanner, the pieces are conveyed to a scale that weighs each piece. After determining the recipient's address and the weight of a piece, the system determines the proper postage that is required for the

piece. The piece is then conveyed to a labeler that print postage information on a label and then applies the label to the piece. The pieces are then conveyed to a verifier that verifies that the label was properly printed and applied. From the verifier, the pieces are sorted into a plurality of bins based on a variety of characteristics, such as the weight and/or destination determined for the piece.

The advantage of Applicants' system is that it allows a wide variety of mail to be automatically processed in a single batch. There is no need to try to sort the various types of mail to process them separately. The system prepares the pieces for mailing and sorts the various pieces together according to various criteria that the user can specify for each batch of mail.

In contrast, Sansone '287 is directed to a communication system for automatically communicating various information to and from mailing stations and verifying the accuracy of bulk processing machines. Specifically, large mail customers expend considerable resources processing bulk mail according to Post Office regulations in order to qualify for substantial postage discounts. Certain facilities are designed to process and certify that the mail meets the regulations to qualify for the bulk rate discounts. It would not be efficient for the Post Office to examine each piece of mail to ensure that it qualifies for the bulk mail discount. Therefore, mail processed by a qualified bulk mailing center is accepted as qualifying for bulk discounts if the processor provides a certification with the mail indicating that the procedures for qualifying for discount have been followed. Although the certification may be inaccurate in some instances, it is not feasible for the Post Office to visit every bulk mailing site to verify that the machinery is operating properly and that the mail is being processed properly so that it qualifies for the bulk mail discounts.

Sansone '827 addresses the problem of certifying the bulk mail processing centers by providing a communications system of remotely monitoring certain aspects of the bulk mail processing systems to ensure that the systems are

operating properly and to ensure that the systems are operating under the most current rules and regulations.

Another aspect of Sansone '827 to consider is that it is directed to bulk mail and how it is processed. A bulk mailing assumes that all of the pieces in a batch are the same pieces going to different people. The pieces are the same shape, size and weight. The pieces are generally separated into groupings, such as grouping of 125 pieces or groupings of a certain amount of weight, such as 15 lbs. The postage computation is determined for the group based on various features, such as whether each of the mail pieces weighs less than a certain amount, and how much pre-processing has been done to the mail. Based on this information, the postage is computed for the entire group. There is no postage for a specific piece. Further, the weight of a piece is not used to determine the postage for the specific piece. Since all of the pieces in a batch are to be identical, the weight of the pieces simply detects whether the piece is in the proper batch. In other words, if a piece weighs more than the other pieces in a batch, it is not in the proper batch because it is not the same weight.

As can be seen from the foregoing, Sansone '827 and Applicants' system are directed to vastly different situations and are designed to address unrelated problems. Although there is some over-lap in the elements used by two systems, there are significant differences between the Sansone '827 system and Applicants' system as set forth in the claims. The differences between Sansone '827 and the claims are discussed further below. However, the following discussion addresses the concerns with how the numerous patents are combined before addressing the specific differences in the claims.

The Combination of References Uses Applicants' Invention as a Road Map

The Examiner recognizes that Sansone '827 does not teach all of the features of Applicants' claims. However, the Examiner has combined Sansone '827

with numerous other references to meet the features of the claims. However, there is no teaching or suggestion of the changes suggested by the Examiner. In fact, the operation of the various systems strongly teaches away from the changes proposed by the Examiner.

The Federal Circuit has repeatedly emphasized the importance of showing evidence of a motivation to combine the prior art references in the manner suggested. It is not enough to say that one would or could combine references in a particular way. It is the Examiner's burden to provide "actual evidence" of the motivation. In re Dembiczak, 50 U.S.P.Q. 2d 1614,1617 (Fed. Cir. 1999). According to the Federal Circuit:

Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blue print for piecing together the prior art to defeat patentability—the essence of hindsight.

Id.

In In re Dembiczak, the inventor had created a trash bag made of orange plastic and decorated with lines and facial features, so that when the bag was filled it resembled a jack-o-lantern. The Examiner erroneously combined a conventional prior art plastic trash bag with an article teaching the construction of stuffed paper bags decorated to look like jack-o-lanterns. The combination was erroneous because there was no teaching in the references to modify the teachings in the way that the inventor had so done. The fact that both references was directed to bags was not enough. Why would someone think to combine features of a large orange trash bag and a small decorated arts and crafts paper bag?

Similarly, the Examiner appears to combine Sansone '827 and the numerous other references simply because they are directed to mail processing systems. But the Examiner's burden requires actual evidence.

Further still, the references teach away from the proposed combination. For instance, the Examiner contends that it would be obvious to modify Sansone '827 to incorporate a labeler used in Sansone 5,925,864. But the Examiner has not met the threshold question of why? And the answer to the question why must come from the references, not from Applicants' application.

The problem is that Sansone '827 is directed to bulk mail processing that simply requires a bulk mail permit instead of a stamp. Further, since bulk mail is uniform it is most efficient to pre-print the bulk mail permit right on the piece of mail. Printing a label and applying a label onto a piece of mail might seem straight forward, but in the field of bulk mailing it would be a huge cost that would be unnecessary. Furthermore, labeling not only adds an unnecessary expense to the Sansone '827 process, it adds an unnecessary level of complexity to the Sansone '827 system. There is no risk of a labeler jamming, running out of labels or improperly applying a label if the bulk mail permit is printed right on the piece of mail—as it is in reality. Furthermore, even if we assume for the sake of argument that somehow Sansone '827 suggests incorporating a labeler, there would be no suggestion to print a label based on characteristics of each individual piece. All of the pieces in a batch of mail for Sansone '827 would be uniform pieces. Therefore, the entire batch would get the same label, whereas in Applicants' system the label is determined for each piece according to various determined characteristics of each piece.

Similarly, the combination of Sansone '827, Sansone '864 and Kolisch '082 is even further flawed. The operation of the Kolisch device is completely irrelevant to the Sansone '827 device. The only reason the Examiner would have to import the features of Kolisch into Sansone '827 is to re-create Applicants' claims. There is no teaching in the references of any motivation for combining them. In In re Dembiczak, it was inappropriate to combine the references simply because they were bags; in this instance, it is not appropriate to pick and choose elements from the three patents simply because they are all mail processing systems.

In short, there simply is no "actual evidence" in any of the references to combine the references as suggested in the Official Action. Instead, the Examiner has used Applicants' claims as a road map to go through the prior art references picking and choosing various features to combine together. Without using such hindsight, there would be no reason to modify the references as proposed by the Examiner. Accordingly, Applicants request that the Examiner reconsider the rejection of the pending claims.

Claim 1

As discussed above, there is no teaching or suggestion to add a labeler to Sansone '827 as recited in claim 1. Further, claim 1 recites a processor operable to determine the postage required for a piece of mail in response to the weight of the piece of mail. Sansone '827 does not teach such a feature.

Sansone '827 teaches that the pieces are weighed and appropriate postage is applied. However, Sansone '827 does not say that the appropriate postage is based on the weight of the piece. As discussed previously, Sansone is directed to bulk mailing. Therefore, a batch of mail will be uniform mail-each piece of mail should be the same weight. The weighing may be done to ensure that a piece is a proper piece in a batch or to ensure that two pieces are not stuck together. Regardless, Sansone does not teach or suggest a processor that determines the postage required for a piece of mail in response to the weight of the piece of mail. The Examiner is reading that into the mail simply because Sansone says that the system weighs the piece and then applies the appropriate postage.

Since Sansone '827 does not teach or suggest a processor operable to determine the postage required in response to the weight of a piece, claim 1 is patentable over Sansone '827. Further, since there is no teaching or suggestion in the reference to modify Sansone '827 to include such features, claim 1 is patentable over Sansone '827 alone or in combination with the cited references.

Further still, claim 2 recites that the processor is operable to determine the postage required in response to the weight and the scanned address. Again, there is nothing in Sansone '827 that teaches that the appropriate postage is based on the scanned address and the weight of a piece. Of course, there would be no reason for such a determination in a bulk mail preparation system, because again, the weight of the pieces for a batch is uniform.

It appears that the Examiner is citing the new reference Wells 6,510,992 for the proposition that the reference teaches a system for that determines the appropriate postage based on the scanned address and weight of a piece. However, this is a mis-reading of Wells. Referring to col. 8, lines 25-34, the Wells system does not scan each piece until after the postage is applied. Therefore, it is not possible for the system to apply the appropriate postage based on the scanned address. Accordingly, to the extent that the rejection of claim 2 was based on Well, Applicant requests that the Examiner reconsider the rejection.

Further, the Examiner appears to cite Wells as teaching a sorting station. However, the Examiner provides no evidence of any suggestion in Sansone '827 or Wells for modifying Sansone '827 to include a sorting feature from Wells. Further, as discussed above, since Sansone is directed to processing bulk mail that is uniform in weight, there would be no suggestion to sort mail based on the weight and address information for the mail. Further still, although Wells discusses a sorting system, there is no teaching or suggestion that the sorting system sorts in response to the determined address information and weight. It simply mentions that the system has OCR, a printer, in-line weighing and a plurality of sorting bins. There is no teaching or suggestion of the basis for sorting the pieces. Accordingly, Wells does not make-up the short comings in Sansone '827.

Independent claims 13, 31, 42, 45 and 48 are patentable over the prior art of record for reasons similar to those set forth above. Further, newly presented claims 50-65 depend from the previous claims and are patentable for at least the reasons:

set forth above. Additionally, none of the prior art teaches the combination of features in newly presented independent claim 65 or dependent claims 66-69. Accordingly, Applicants request that the Examiner favorably consider newly presented claims 50-69.

In light of the foregoing, Applicant believes that this application is in form for allowance. The Examiner is encouraged to contact Applicant's undersigned attorney if the Examiner believes that issues remain regarding the allowability of this application

Respectfully submitted,

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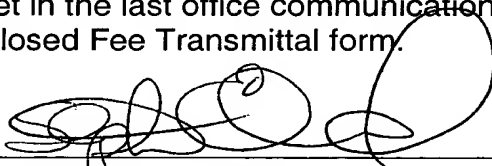
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Petition for Extension Under 37 CFR §1.136(a)

Applicant's undersigned Attorney hereby petitions for an extension of time of **ONE** month beyond the time period set in the last office communication. The proper fee is enclosed as identified in the enclosed Fee Transmittal form.

May 15, 2006
Date of Certificate


Stephen H. Eland
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